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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,519	11/06/2003	Hugh C. Gardner	37,459-01	7372

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EXAMINER
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JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/701,519	Applicant(s) GARDNER ET AL.	
	Examiner Cheryl Juska	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2005.  
 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
     4a) Of the above claim(s) 10-20 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-9 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>04/05/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-9 in the reply filed on March 22, 2005 is acknowledged. The traversal is on the ground(s) that the reason given in the restriction requirement for distinctness between Groups II and III is "inconsistent with both parts (1) and (2) of MPEP 806.05(f) (Election, page 4, 4<sup>th</sup> paragraph). This is not found persuasive because MPEP 806.05(f) states that groups of claims drawn to a process of making and a product made and are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process. As stated in the restriction requirement, the process of making the carpet can be performed employing a conventional secondary carpet backing, since the limitation to the carpet backing of claim is recited as a structural limitation in an article claim and is not an active method step of making the carpet.

2. With respect to the distinctness of Groups I and II, applicant argues that the fact that the claims possess a common concept and corresponding language in both groups rebuts the distinctness asserted by the examiner (Election, paragraph spanning pages 4-5). This is unpersuasive since MPEP 806.04(h) states distinctness between intermediate-final products is proven if the intermediate product is useful to make products other than the claimed final product and the species are patentably distinct. In the instant case, the intermediate product is deemed to be useful as a woven fabric suitable for use as a stand-alone fabric or may be employed in variety of composite/laminate structures such as those used in building or structural panels or geotextiles.

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Additionally, the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants.

3. With respect to the distinctness of the claims of Groups I and III, applicant asserts that the dependency of the Group III claims on Group I weighs against any asserted distinctness of utility and both groups of claims reflect a common inventive concept (Election, page 5, 3<sup>rd</sup> paragraph). This is unpersuasive since a common inventive concept is not the basis for non-distinctness according to US patent prosecution. MPEP 806.05(h) states distinctness between a product and a process of use can be shown if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. In the instant case, the carpet backing of Group I can be used to make other composite materials such as panels, reinforced impact resistant materials or geotextiles. With respect to the dependency of the claims in Group III on the claims of Group I, dependency of claims is not a proper ground for non-distinctness of inventions.

4. The requirement is still deemed proper and is therefore made FINAL.

5. Claims 10-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/293,119. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the two sets of claims is the range of multifilament picks/in. The present application limits said range to about 10-20, while the copending application limits the range to about 12-20. Thus, the present claims are fully encompass the narrower range of application 10/293,119.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 1 limits the picks to multifilament yarns, while claim 7 limits said picks to spun yarns. Where applicant acts as his or her own lexicographer to

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specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). “Spun yarns” are defined in the art as “a yarn consisting of staple fibers usually bound together by twist.” The term “multifilament yarn” in claim 1 is used by the claim to mean “a yarn made of more than one continuous filament or staple fiber”, while the accepted meaning is “a yarn made of continuous filaments.” The term is indefinite because the specification does not clearly redefine the term.

### ***Claim Rejections - 35 USC § 102/103***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claims 1-7 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 6,435,220 issued to Smith et al.

Applicant claims a carpet backing comprising a woven flat weave fabric having 12-24 warp tape yarns per inch, preferably 13-18 warps/in and 10-20 multifilament picks per inch, preferably 13-17 picks/in. Said fabric has a basis weight of 1.5-7 osy and an average air permeability of at least  $250 \text{ ft}^3/\text{min}/\text{ft}^2$ . Said warp yarns provide 50-100%, preferably 55-90%, theoretical warp coverage but less than full effective warp coverage. The backing preferably has warp tapes of polypropylene having widths of 40-100 mils. The picks preferably have a denier of 1000-2500 and are spun yarns. The flat weave is preferably a plain weave.

Due to the lack of an explicit definition in the specification, for the purposes of examination, the term "flat weave" is interpreted in its broadest reasonable meaning. Specifically, "flat weave" is interpreted as any woven fabric that is not a 3-D weave, a pile weave, or a double weave fabric. This interpretation includes leno weaves as a flat weave fabric.

Smith '220 discloses a woven carpet backing comprising monofilament warp yarns and alternating monofilament and multifilament weft yarns (abstract). The monofilament warps may be tape yarns, (col. 4, lines 30-31 and col. 5, lines 33-35), made of polypropylene (col. 5, lines 24-28); and have widths of about 0.04-0.06 inches (col. 8, lines 40-45). The backing is woven with about 10-40 warps/in and about 10-50 picks/in (col. 5, lines 1-10). The denier of the warp yarns may be in the range of 100-900, while the denier of the weft yarns may be in the range of 250-2000 (col. 5, lines 11-23). The weft yarns may be spun yarns (col. 5, lines 30-33). The backing has a total coverage factor of about 90% to 300% (col. 4, lines 55-57).

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Thus, Smith teaches the presently claimed invention with the exception of the recited properties of basis weight and air permeability. However, it is reasonable to presume that these properties are inherent to the invention. Support for said presumption is found in the use of like materials (i.e., like denier polypropylene, monofilament tape warp yarns and multifilament weft yarns) used to produce a woven fabric having the same weave density and coverage. The burden is upon the applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 495. In the alternative, the claimed basis weight and air permeability would obviously have been provided by the process disclosed by Smith. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. Therefore, claims 1-7 are rejected as being anticipated by or obvious over the cited Smith patent.

***Claim Rejections - 35 USC § 103***

13. Claims 1-7 are rejected under 35 U.S.C. 103(a) as obvious over applicant's own admission.

Applicant admits that common prior art secondary backings are comprised of polypropylene warp tapes and spun yarn picks woven in an open, leno weave construction (section [0006] of Pre-Grant Publication 2004/0142142). Said common backings typically have 12-24 warps/in and 5-15 picks/in (section [0006]). Applicant also describes a known commercial product, ActionBac<sup>®</sup> Fabric style 3808 which has a count of 18 warps/in and 13 picks/in and an average air permeability of above 720 ft<sup>3</sup>/min/ft<sup>2</sup> (section [0007]).



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Thus, applicant teaches the invention of claims 1 and 4-7 with the exception of the claimed warp coverage and the basis weight. With respect to the latter, it is asserted that known ActionBac<sup>®</sup> fabrics have basis weights within the range claimed by applicant. As such, it would have been readily obvious to one skilled in the art to select a backing fabric within the range claimed. With respect to the former, it is argued that the claimed coverage would be provided upon selection of the ActionBac<sup>®</sup> fabric since said fabric meets all the structural and chemical features of the claimed invention. If applicant traverses this point, it will be argued that the claim is incomplete in that the structural and chemical features which provide the claimed coverage property are not recited in the claim. Therefore, claims 1 and 4-7 are obvious over applicant's own admission.

Additionally, it would have been obvious to one skilled in the art to select the claimed tape width and the spun yarn deniers since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 205 USPQ 215. Yarn width and/or denier will affect the yarn coverage, basis weight, and air permeability of a fabric. As such, one skilled in the art can readily determine appropriate values based upon the desired end use. Therefore, claims 2 and 3 are also rejected.

14. Claims 1-9 are rejected under 35 U.S.C. 103(a) as obvious over US 6,060,145 issued to Smith et al.

Smith '145 discloses a modified secondary backing comprising a conventional secondary backing scrim and a fiber batt needled thereto (abstract and col. 8, lines 46-52). The preferred conventional secondary backing comprises a leno weave of 16 warps/in by 5 picks/in (col. 13,

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line 64-col. 14, line 1). However, Smith '145 teaches other fabrics having different counts and/or weaves, such as plain, satin, or twill weaves, are also within the scope of the invention.

While Smith '145 does not exemplify any of these other embodiments, it is argued that the presently claimed invention is obvious over the Smith '145 disclosure. Specifically, one skilled in the art readily understands the relationships between yarn denier or width, yarn count, and fabric weave to the properties of basis weight, permeability, and coverage. For example, one skilled in the art, understands an increase in yarn count produces an increase in basis weight and coverage, while producing a decrease in air permeability. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 205 USPQ 215. Short of a showing of unexpected results, it is argued that the claimed invention is readily obvious to one skilled in the art as an optimization of result effective variables. Therefore, claims 1-9 are obvious over the known prior art.

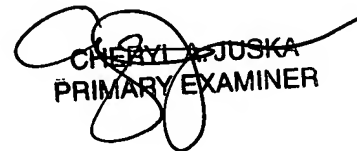
### ***Conclusion***

15. The art made of record and not relied upon is considered pertinent to applicant's disclosure.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CHERYL A. JUSKA  
PRIMARY EXAMINER

cj  
May 27, 2005